

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

***Ex parte*** JOHN E. GATTI

---

Appeal No. 95-1515  
Application 08/027,656<sup>1</sup>

---

ON BRIEF

---

Before HAIRSTON, FLEMING and CARMICHAEL, ***Administrative Patent Judges.***

FLEMING, ***Administrative Patent Judge.***

***DECISION ON APPEAL***

This is a decision on appeal from the final rejection of  
claims 1 through 9, all of the claims pending in the  
application. Appellant's invention relates to creating

---

<sup>1</sup>Application for patent filed March 8, 1993.

Appeal No. 95-1515  
Application 08/027,656

combined photographic or slide transparency copies of two existing slide transparencies.

Independent claim 1 is reproduced as follows:

1. A photographic apparatus for attachment to a camera lens for simultaneously creating a single slide transparency or photograph from a plurality of slide transparencies having distinct images exposed thereon, comprising:

an enclosure formed from a plurality of opaque sides and at least one translucent side, said enclosure having an aperture therethrough at a proximal side and having means for connecting the same to a camera and aligning said aperture with the camera lens, said enclosure further having means located therein for holding said slide transparencies; and

means within said enclosure for directing images formed from light rays passing through said at least one translucent side and separately through each of said plurality of slide transparencies to and into alignment with said camera lens.

The references relied on by the Examiner are as follows:

Ramsdell	2,413,996	Jan. 07, 1947
Papritz	2,736,250	Feb. 28, 1956
Sayanagi	3,674,339	Jul. 04, 1972
Black	3,689,148	Sep. 05, 1972
Murphy	3,815,970	Jun. 11, 1974
Vitou	4,026,651	May 31, 1977
Wyller	4,239,376	Dec. 16, 1980
Mumpower	5,073,789	Dec. 17, 1991

Appeal No. 95-1515  
Application 08/027,656

Claims 1 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Vitou, Black, Mumpower, Wyller, Ramsdell, Papritz, Sayanagi and Murphy.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the brief and the answer for the details thereof.

#### **OPINION**

After a careful review of the evidence before us, we agree with the Examiner that claims 1 through 4, 6 and 7 are properly rejected under 35 U.S.C. § 103. Thus, we will sustain the rejection of these claims but we will reverse the rejection of the remaining claims on appeal for the reasons set forth *infra*.

At the outset, we note that Appellant has indicated on page 3 of the brief the groupings of the claims. In particular, Appellants state that claims 1 through 4 and 7 are grouped together. In addition, on page 9 of the brief, Appellant argues claims 1 through 4 and 7 as one group. 37 CFR § 1.192(c)(5) amended October 22, 1993 states:

For each ground of rejection which  
appellant contests and which applies to

Appeal No. 95-1515  
Application 08/027,656

more than one claim, it will be presumed that the rejected claims stand or fall together unless a statement is included that the rejected claims do not stand or fall together, and in the appropriate part or parts of the argument under subparagraph (c)(6) of this section appellant presents reasons as to why appellant considers the rejected claims to be separately patentable.

As per 37 CFR § 1.192(c)(5), which was controlling at the time of Appellant's filing the brief, we will, thereby, consider Appellant's claims 1 through 4 and 7 to stand or fall together,

with claim 1 being considered the representative claim. We will treat claims 5, 6 , 8 and 9 separately.

On pages 4 and 5 of the brief, Appellant argues that there is no suggestion in the references to combined in the manner suggested by the Examiner. Appellant argues that a person skilled in the art who was looking to develop an attachment that would allow a camera to photograph two separate and distinct slides and create a single slide with the two original slides reproduced next to each other would

Appeal No. 95-1515  
Application 08/027,656

hardly be inclined to combine any of the first group of references (Vitou, Black, Mumpower and Wyller) with the second group of references (Ramsdell, Papritz, Sayanagi and Murphy).

It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). In addition, the Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), ***citing*** ***In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In addition, the Federal Circuit reasons in ***Para-Ordinance Mfg. Inc. v. SGS Importers Int'l Inc.***, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), ***cert.***

**denied**, 117 S.Ct. 80 (1996), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellant.

The Examiner points to Vitou for a suggestion to combine the apparatus for making a single photograph from two photographs as taught in the second group of references (Ramsdell, Papritz, Sayanagi and Murphy) with camera structure for making a photograph of a photograph as taught in the second group of references (Vitou, Black, Mumpower and Wyller). In particular, we note that Vitou teaches in column 1, lines 15-19, that it is sometimes desirable to reproduce one of more positive images on the same frame of film.

After a careful review of the references, we find that from the suggestion found in Vitou, those skilled in the art would have looked to the teaching of the second group of references (Ramsdell, Papritz, Sayanagi and Murphy) to modify

the camera as taught in the first group of references (Vitou, Black, Mumpower and Wyller) to obtain a photographic apparatus for attachment to a camera lens for simultaneously creating a single slide transparency or photograph from a plurality of slide transparencies having distinct images exposed thereon as recited in Appellant's claim 1.

Appellant further points out on pages 4 and 5 of the brief that the second group of references (Vitou, Black, Mumpower and Wyller) makes a single photograph from two photographs where the two photographs are of an image simultaneously photographed from two angles. Appellant argues that since the two photographs are of the same image viewed from two different angles that the two photograph are not two different slide transparencies.

We disagree. Vitou, Black, Mumpower and Wyller teach that the photographs are not the same image but the same subject viewed from two different angles. Furthermore, we note that Appellant's claim 1 language only requires that the slide transparencies have distinct images exposed thereon. The claim language does not preclude images of the same

subject at different angles. An image of a subject at one angle is a distinct image from another image of the subject at another angle. Therefore, we will sustain the Examiner's rejection of claims 1 through 4 and 7.

On page 5 of the brief, Appellant argues that first surface mirrors recited in claim 6 are utilized to guarantee the reflection of only one image. However, we note that claim 6 only recites that the "mirror means comprises first surface mirrors" and does not require the limitation as argued by Appellant. We find that the Examiner's finding that Murphy, Papritz and Sayanagi teach first surface mirrors as recited in Appellant's claim 6 is reasonable. Therefore, we will sustain the Examiner's rejection of claim 6.

On pages 5 and 6 of the brief, Appellant argues the limitations recited in claims 5, 8 and 9. The Examiner has not shown how the references read on these limitations. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires



Appeal No. 95-1515  
Application 08/027,656

this evidence in order to establish a *prima facie* case. *In re Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

In view of the foregoing, the decision of the Examiner rejecting claims 1 through 4, 6 and 7 under 35 U.S.C. § 103 is affirmed; however, the decision of the Examiner rejecting claims 5, 8 and 9 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

***AFFIRMED-IN-PART***

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
	)	
JAMES T. CARMICHAEL	)	

Appeal No. 95-1515  
Application 08/027,656

Administrative Patent Judge )

VSH

Appeal No. 95-1515  
Application 08/027,656

Norman E. Lehrer  
1205 North Kings Highway  
Cherry Hill, NJ 08034